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JAY H MAIOLI  
COOPER & DUNHAM  
1185 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER

LIN, KENNY S

ART UNIT PAPER NUMBER

2154

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/462,789

Applicant(s)

YODO ET AL.

Examiner

Kenny Lin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-31 are presented for examination.
2. It is noted that although the present application does contain line numbers in the specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.

### Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 2-6, 12-21 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a. The following terms lack proper antecedence basis:
    - i. Said index information – claims 2 and 12;
    - ii. Said charging processing portion – claim 6 (when amending “charging processing portion” to “charge processing portion”, this one is not amended);
    - iii. said charge processing portion – claims 9, 17, 19-21 and 24 (when amending “charging processing portion” to “charge processing portion”,

this one is not amended where it is the antecedence basis of all other amended ones. As per claim 24, lack of antecedence basis);

iv. reproduction permission signal – claims 10, 18 and 21 (is it the same as permission signal?);

v. data – claim 26 (multiple antecedences. It is content data, charging data, or permission data?).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Morioka et al and Ito et al**

6. Claims 1, 7-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morioka et al, U.S. Patent Number 6,324,334, in view of Ito et al, U.S. Patent Number 6,085,019.

7. As per claim 1, Morioka et al taught the invention substantially as claimed including a recording and reproducing apparatus (fig.1, col.2, lines 19-22), comprising:

a. A storing portion for storing at least one program of content data (col.18, lines 8-11);

- b. A recording and reproducing portion for writing content data to said storing portion and reading stored content data from said storing portion (col.18, line 65 to col.19, line 6, col.19, lines 15-36); and
- c. A signal generating portion for generating a signal that allows said recording and reproducing portion to reproduce said stored content data stored in said storing portion (col.4, lines 57 to col.5, line 7),

Wherein when said signal generating portion transmits said signal to said recording and reproducing portion, said recording and reproducing portion reproduces said stored content data stored in said storing portion (col.15, lines 9-12, 19-26).

8. Morioka et al did not specifically teach that the generated signal is a permission signal. Morioka et al taught a control signal being generated and transmitted to control the recording and reproducing portion to reproduce content data. Ito et al taught to use permission signal to trigger reproducing (col.7, lines 45-66). In addition, it is well known in that art that permission signal can be included in a control signal where the control signal also authorized certain procedures to be performed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morioka et al and Ito et al because Ito et al's teaching of using a permission signal to trigger recording and reproducing portion to start reproducing provides levels of authentication.

9. As per claim 11, Morioka et al taught the invention substantially as claimed including a recording and reproducing apparatus (fig.1, col.2, lines 19-22), comprising:

- a. A recording and reproducing portion, having a storing portion for storing at least one program of content data (col.18, lines 8-11), for writing content data to said storing portion and reading stored content data from said storing portion (col.18, line 65 to col.19, line 6, col.19, lines 15-36);
- b. A server unit (col.18, lines 1-7, 34-42) having a signal generating portion for generating a signal that allows said recording and reproducing portion to reproduce said stored content data stored in said storing portion (col.4, lines 57 to col.5, line 7),

Wherein if said signal generating portion transmits said signal to said recording and reproducing portion, said recording and reproducing portion reproduces said stored content data stored in said storing portion (col.15, lines 9-12, 19-26).

10. Morioka et al did not specifically teach that the generated signal is a permission signal. Morioka et al taught a control signal being generated and transmitted to control the recording and reproducing portion to reproduce content data. Ito et al taught to use permission signal to trigger reproducing (col.7, lines 45-66). In addition, it is well known in that art that permission signal can be included in a control signal where the control signal also authorized certain procedures to be performed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morioka et al and Ito et al because Ito et al's teaching of using a permission signal to trigger recording and reproducing portion to start reproducing provides levels of authentication.

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11. As per claim 7, Morioka et al and Ito et al taught the invention substantially as claimed in claim 1. Morioka et al further taught to include a terminal unit connected to the recording and reproducing portion and a server unit containing the signal generating portion that the server unit is being connected to the terminal unit through a communication network (col.18, lines 1-7, 34-42).

12. As per claim 8, Morioka et al and Ito et al taught the invention substantially as claimed in claim 1. Morioka et al further taught to include a terminal unit containing the signal generating portion, the terminal unit being connected to the recording and reproducing portion and a server unit connected to the terminal unit through a communication network (col.18, lines 1-7, 34-42).

**Morioka et al, Ito et al and Ohkuma et al**

13. Claims 2-3 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morioka et al, U.S. Patent Number 6,324,334, Ito et al, U.S. Patent Number 6,085,019, as applied to claims 1 and 11 above, and further in view of Ohkuma et al, U.S. Patent Number 5,574,570.

14. As per claims 2 and 12, Morioka et al and Ito et al taught the invention substantially as claimed in claims 1 and 11. Ito et al further taught that wherein said storing portion stores index data along with said content data (col.7, lines 31-37). Morioka et al and Ito et al did not specifically teach that said recording and reproducing portion rewrites said index data corresponding to permission signal (col.8, lines 45-61) so as to allow said recording and

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reproducing portion to reproduce said stored content data stored in said storing portion corresponding to said rewritten index data (col.9, lines 45-48).

15. Ohkuma et al taught that the index data can be rewritten (col.8, line 62 to col.9, line 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morioka et al, Ito et al and Ohkuma et al because Ohkuma et al's teaching of rewriting index data allows the recording and reproducing apparatus taught by Morioka et al and Ito et al to store program number or time data when more data is appended to the storing portion.

16. Morioka et al, Ito et al and Ohkuma et al did not specifically disclose that the rewritten index data is corresponding to the permission signal so that the reproduced content data corresponds to the rewritten index data. However, since the index data/rewritten index data is stored along with the content data and that the permission signal is transmitted to control/permit the starting of reproducing stored content data, it would have been obvious to one of ordinary skill in the art at the time the invention was made to conclude that the permission signal and the reproduced content data are corresponding to the rewritten index data.

17. As per claims 3 and 13, Morioka et al, Ito et al and Ohkuma et al taught the invention substantially as claimed in claims 2 and 12. Morioka et al further taught that wherein when the recording and reproducing portion reproduces content data stored in the storing portion, the recording and reproducing portion supplies index data stored in storing data to the signal

generating portion and the signal generating portion generates a permission signal corresponding to the index data received from the recording and reproducing portion (col.5, lines 4-7)

**Morioka et al, Ito et al, Ohkuma et al and Ogura**

18. Claims 4-5 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morioka et al, U.S. Patent Number 6,324,334, Ito et al, U.S. Patent Number 6,085,019, Ohkuma et al, U.S. Patent Number 5,574,570, as applied to claims 3 and 13 above, and further in view of Oguro, U.S. Patent Number 5,907,444.

19. As per claims 4 and 14, Morioka et al, Ito et al and Ohkuma et al taught the invention substantially as claimed in claims 3 and 13. Morioka et al, Ito et al and Ohkuma et al did not specifically teach that the index data is imperfect index data when recording and reproducing portion writes content data to the storing portion and when the stored content data is reproduced, recording and reproducing portion rewrites imperfect index data to perfect index data corresponding to permission signal received from the signal generating portion.

20. Oguro taught that the index data is imperfect index data when recording and reproducing portion writes content data to the storing portion and when the stored content data is reproduced, recording and reproducing portion rewrites imperfect index data to perfect index data corresponding to permission signal received from the signal generating portion (col.20, lines 18-41, 48-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morioka et al, Ito et al, Ohkuma et al and Oguro

because Oguro's teaching of updating imperfect index data to perfect index data provides ways to correctly indicate the existence of information in the storing portion using updated index information (TOC) and prevent possible data overwriting.

21. As per claims 5 and 15, Morioka et al, Ito et al, Ohkuma et al and Ogura taught the invention substantially as claimed in claims 4 and 14. Morioka et al, Ito et al, Ohkuma et al and Ogura did not specifically teach that the permission signal is perfect index data of content data read from the storing portion and reproduced by recording and reproducing portion. However, it would have been obvious that in order to rewrite the imperfect index data to perfect index data corresponding to permission signal, the permission signal generated by signal generating portion must be perfect index of content data read from the storing portion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to generate the permission signal as perfect index data of content data in order to correctly overwrite the imperfect index data.

**Morioka et al, Ito et al and Ohkuma et al and Russo**

22. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morioka et al, U.S. Patent Number 6,324,334, Ito et al, U.S. Patent Number 6,085,019, Ohkuma et al, U.S. Patent Number 5,574,570, as applied to claims 2 and 12 above, and further in view of Russo, U.S. Patent Number 5,619,247.

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23. As per claims 6 and 16, Morioka et al, Ito et al and Ohkuma et al taught the invention substantially as claimed in claims 2 and 12. Ito et al further taught wherein when said recording and reproducing portion reproduces content data stored in said storing portion, said recording and reproducing portion supplies said index data to said signal generating portion (col.7, lines 31-37, col.8, lines 10-65). Morioka et al Ito et al and Ohkuma et al did not specifically teach to include a charge processing portion for performing a charging process before said signal generating portion generates said permission signal.

24. Russo taught to have a charge processing portion for performing a charging process (col.3, lines 59-61, col.4, lines 47-53) wherein the recording and reproducing portion supplies a charging process signal to the charge processing portion to perform the charging process (col.10, lines 16-26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morioka et al, Ito et al, Ohkuma et al and Russo because Russo's teaching of charging users on a pay-per-use basis enables Morioka et al, Ito et al and Ohkuma et al's recording and reproducing apparatus to bill for usage.

25. Morioka et al, Ito et al, Ohkuma et al and Russo did not specifically teach that after the charge processing portion has completed the charging process, the signal generating portion generates the permission signal. However, Russo did teach that "the triggering of account debit may occur at different points" (col.10, lines 16-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morioka et al, Ito et al, Ohkuma et al and Russo and further allows signal generating portion to generate

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the permission signal after the charging process is performed in order to bill the users, ensuring the users has correctly input a billing method or sufficient credit amount, before the audio file is reproducing permission is granted.

**Morioka et al, Ito et al and Russo**

26. Claims 9-10 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morioka et al, U.S. Patent Number 6,324,334, Ito et al, U.S. Patent Number 6,085,019, as applied to claims 1 and 11 above, and further in view of Russo, U.S. Patent Number 5,619,247.

27. As per claims 9 and 17, Morioka et al and Ito et al taught the invention substantially as claimed in claims 1 and 11. Morioka et al further taught to have the signal generating portion supplies permission signal to the recording and reproducing portion (col.4, lines 57 to col.5, line 7, col.15, lines 9-12, 19-26). Morioka et al and Ito et al did not specifically teach to include a charge processing portion wherein when the recording and reproducing portion reproduces the stored content data, the recording and reproducing portion supplies a charging process signal to the charge processing portion so that the charge processing portion performs the charging process. Russo taught to have a charge processing portion (col.3, lines 59-61, col.4, lines 47-53) wherein the recording and reproducing portion supplies a charging process signal to the charge processing portion to perform the charging process (col.10, lines 16-26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morioka et al, Ito et al and Russo because Russo's teaching of charging users on a

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pay-per-use basis enables Morioka et al and Ito et al's recording and reproducing apparatus to bill for usage.

28. Morioka et al, Ito et al and Russo did not specifically teach that after the charge processing portion has completed the charging process, the signal generating portion supplies the permission signal to the recording and reproducing portion. However, Russo did teach that "the triggering of account debit may occur at different points" (col.10, lines 16-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morioka et al, Ito et al and Russo and further allows signal generating portion to supply the permission signal to the recording and reproducing portion after the charging process is performed in order to bill the users, ensuring the users has correctly input a billing method or sufficient credit amount, before the audio file is reproduced.

29. As per claims 10 and 18, Morioka et al, Ito et al and Russo taught the invention substantially as claimed in claims 9 and 17. Ito et al further taught that wherein the storing portion stores and said reproduction permission signal along with said content data, and said recording and reproducing portion rewrites said reproduction permission signal corresponding to said permission signal received from said signal generating portion (col.4, lines 40-47, col.7, lines 31-37). Russo further taught that wherein the storing portion stores the charging process signal along with the content data (col.4, lines 47-53).

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30. As per claim 19, Morioka et al, Ito et al and Russo taught the invention substantially as claimed in claim 17. Morioka et al further teach that recording and reproducing portion is connected to the server unit through a communication network (col.18, lines 1-7, 34-42). Morioka et al and Ito et al did not specifically teach that a charge processing portion connected to recording and reproducing portion. However, a charge processing portion connected to recording and reproducing portion is rejected for the same reason in claim 17 using Russo.

31. As per claim 20, Morioka et al, Ito et al and Russo taught the invention substantially as claimed in claim 19. Morioka et al, Ito et al and Russo did not specifically teach to include identification data for the terminal unit. However, it is well known in the art to use authenticating process to gain Network security and also to verify proper user account information using identification data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide authenticating process to check identification data for the terminal unit to Morioka et al, Ito et al and Russo's reproducing apparatus to ensure Network security and verify proper billing information.

32. As per claim 21, Morioka et al, Ito et al and Russo taught the invention substantially as claimed in claim 20 including that charge processing portion connected to said server unit through the communication network (see claim 19 rejection) and charge processing portion performs charging process (see claim 17 rejection). Ito et al further taught rewrite reproduction permission signal corresponding to permission signal received from said signal generating portion (col.4, lines 40-47, col.7, lines 31-37).

**Ito et al and Ohkuma et al**

33. Claim 22-23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al, U.S. Patent Number 6,085,019, in view of Ohkuma et al, U.S. Patent Number 5,574,570.

34. As per claim 22, Ito et al taught the invention substantially as claimed including a data reproducing method comprising the steps of:

- a. Issuing a content data transmission request to a server unit, said content data transmission request causing a server unit to transmit index data corresponding to stored content data reproduced from a storing portion of a terminal unit, said storing portion storing at least one program of content data and the index data (col.3, line 53 to col.4, line 7, col.4, lines 26-46, col.6, line 5-12, col.7, lines 15-36);
- b. Causing said server unit to transmit said index data of said stored content data reproduced by said terminal unit corresponding to said transmission request received from the terminal unit (col.6, line 5-12, col.7, lines 15-36); and
- c. Causing said terminal unit to reproduce said stored content data stored in said storing portion (col.8, lines 45-65).

35. Ito et al did not specifically teach the steps of:

- a. Causing said terminal unit to rewrite said index data stored in said storing portion corresponding to the index data received from said server unit; and
- b. The reproduce content data is corresponding to the rewritten index data.

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However, Ohkuma et al taught to rewrite index data (col.8, line 62 to col.9, line 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ito et al and Ohkuma et al because Ohkuma et al's teaching of rewriting index data allows the recording and reproducing apparatus taught by Ito et al to store program number or time data when more data is appended to the storing portion.

36. Ito et al and Ohkuma et al did not specifically disclose that the reproduced content data corresponds to the rewritten index data. However, since the index data/rewritten index data is stored along with the content data, it would have been obvious to one of ordinary skill in the art at the time the invention was made to conclude that the reproduced content data are corresponding to the rewritten index data.

37. As per claim 23, Ito et al and Ohkuma et al taught the invention substantially as claimed in claim 22. Ito et al further taught that wherein when said terminal unit reproduces the stored content, the terminal unit supplies said index data so server unit and server unit supplies perfect index data to terminal unit corresponding to the received index data (col.6, line 5-12, col.7, lines 15-36, col.8, lines 45-65).

**Ito et al, Ohkuma et al and Oguro**

38. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al, U.S. Patent Number 6,085,019, and Ohkuma et al, U.S. Patent Number 5,574,570 as applied to claims 22-23 above, and further in view of Oguro, U.S. Patent Number 5,907,444.

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39. As per claim 24, Ito et al and Ohkuma et al taught the invention substantially as claimed in claims 23. Ito et al and Ohkuma et al did not specifically teach that the index data is imperfect index data when recording and reproducing portion writes content data to the storing portion and when the stored content data is reproduced by the terminal unit, charge processing portion rewrites imperfect index data corresponding to perfect index data.

40. Oguro taught that the index data is imperfect index data when recording and reproducing portion writes content data to the storing portion and when the stored content data is reproduced by the terminal unit, charge processing portion rewrites imperfect index data corresponding to perfect index data (col.20, lines 18-41, 48-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morioka et al, Ito et al, Ohkuma et al and Oguro because Oguro's teaching of updating imperfect index data to perfect index data provides ways to correctly indicate the existence of information in the storing portion using updated index information (TOC) and prevent possible data overwriting.

#### **Russo**

41. Claims 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo, U.S. Patent Number 5,619,247.

42. As per claim 25, Russo taught the invention substantially as claimed including a data reproducing method, comprising the steps of:

- a. Reading charging data stored in a storing portion when a terminal unit (4, fig.1) having said storing portion (14, fig.1) for storing at least one program of content data and charging data corresponding thereto is connected to a charge processing unit (col.3, lines 60-62, col.4, lines 28-53, col.6, lines 55-58, col.7, lines 35-51, col.10, lines 16-26); and
- b. A server unit (col.3, lines 45-47).

43. Russo did not specifically teach the steps of:

- a. Transmitting said charging data that is read from said storing portion to said charge processing unit and to a server unit connected thereto through a communication network so as to perform a charging process; and
- b. Allowing said terminal unit to reproduce stored content data stored in said storing portion after said charging process has been completed between said charge processing unit and said server unit.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to enhance the data reproducing method taught by Russo to transmit the charging data from the storing portion to charge processing unit for charging if the charge processing unit is connected on the server unit through a communication network but not connected or build within the storing portion. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data reproducing method taught by Russo to allow the terminal unit to reproduce stored content data after the charging process has been performed to ensure payment is received.

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44. As per claim 29, Russo taught the invention substantially as claimed including a data reproducing method, comprising the steps of:

- a. Storing at least one program of content data in a first storing portion (14, fig.1, col.4, lines 10-13) and storing charging data that represents charging information of stored content data in a second storing portion of a terminal unit (col.3, lines 60-64);
- b. Reading charging data stored in said second storing portion when a terminal unit (4, fig.1) is connected to a charge process unit (col.3, lines 60-62, col.4, lines 28-53, col.6, lines 55-58, col.7, lines 35-51, col.10, lines 16-26); and
- c. A server unit (col.3, lines 45-47).

45. Russo did not specifically teach the steps of:

- a. Transmitting said charging data that is read from said storing portion to said charge processing unit and to a server unit connected thereto through a communication network so as to perform a charging process; and
- b. Allowing said terminal unit to reproduce stored content data stored in said storing portion after said charging process has been completed between said charge processing unit and said server unit.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to enhance the data reproducing method taught by Russo to transmit the charging data from the storing portion to charge processing unit for charging if the charge processing unit is connected on the server unit through a communication network but not connected or build within

the storing portion. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data reproducing method taught by Russo to allow the terminal unit to reproduce stored content data after the charging process has been performed to ensure payment is received.

**Russo and Ito et al**

46. Claims 26-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo, U.S. Patent Number 5,619,247, as applied to claims 25 and 29 above, and further in view of Ito et al, U.S. Patent Number 6,085,019.

47. As per claims 26 and 30, Russo taught the invention substantially as claimed in claims 25 and 19. Russo further taught that wherein the storing portion stores the charging data along with the content data (col.4, lines 47-54). Russo did not specifically teach to:

- a. store permission data;
- b. when permission data is stored with content data and charge data, stored content data can be reproduced;
- c. said permission data is rewritten to data allowing the stored content data stored in said storing portion to be reproduced after charging process has been completed between said charging processing unit and server unit.

48. Ito et al taught to store permission data with content data and charge data, and permission data is rewritten to data allowing the stored content data stored in said storing portion to be

reproduced (col.4, lines 37-47, col.7, lines 31-37). Russo and Ito et al did not specifically teach that the reproduction is performed after charging process has been completed between said charging processing unit and server unit. However, Russo did teach that “the triggering of account debit may occur at different points” (col.10, lines 16-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Russo and Ito et al because Ito et al’s teaching of rewriting permission data to trigger the reproducing step. In addition, one of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Russo and Ito et al to start the reproducing after the charging process is completed in order to bill the users, ensuring the users has correctly input a billing method or sufficient credit amount, before the audio file is reproduced.

49. As per claims 27 and 31, Russo and Ito et al taught the invention substantially as claimed in claims 26 and 30. Ito et al further taught that wherein when content data is written to said storing portion, said permission data prohibits said stored content data stored in said storing portion from being reproduced (col.4, lines 37-47).

50. As per claim 28, Russo and Ito et al taught the invention substantially as claimed in claims 27. Russo further taught that a terminal unit is connected to said charge process unit (col.3, lines 60-62). Russo and Ito et al did not specifically teach that the charge processing unit performs an authenticating process for terminal unit. However, it is well known in the art to verify user accounts, user login ID and password, user profile (phone number, email and home

address for shipping if needed) and credit/billing information before a service is provided. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide authenticating process to Russo and Ito et al's reproducing method to ensure Network security.

### **Conclusion**

51. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ozawa et al, U.S. Patent Number 5,870,710, disclosed recording and reproducing system connected to a network server.

Tashiro et al, U.S. Patent Number 5,654,516, disclosed recording and reproducing system with rewriteable data.

Shimoda et al, U.S. Patent Number 5,289,190, and Shitara, U.S. Patent Number 5,999,354, disclosed recording and reproducing apparatus.

Nakamura et al, U.S. Patent Number 5,432,646, and Edakubo et al, U.S. Patent Number 6,188,834, disclosed recording and reproducing apparatus with index signal.

52. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (703)305-0438. The examiner can normally be reached on 8 AM to 5 PM Tuesday to Friday and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. Additionally, the fax numbers for Group 2100 are as follows:


Official Responses: (703) 746-7239

After Final Responses: (703) 746-7238

Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-5140.

ksl  
November 4, 2002

  
**MENG-AL T. AN**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**